



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/587,448	12/01/95	HO KEUNG	T

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22M2/0421

AIR MAIL

EXAMINER	
LAUFER, P	
ART UNIT	PAPER NUMBER
2202	#2

DATE MAILED: 04/21/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/587,448

Applicant(s)

Tse Ho Keung

Examiner 703 306 4160

Pinchus M. Laufer

Group Art Unit

2202



☒ Responsive to communication(s) filed on Dec 10, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 and 9-21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 and 9-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 1-7 and 9-21 are rejected under 35 U.S.C. § 101 because they are non-statutory. Claims 1-7 and 9-21 constitute Functional Descriptive Material, i.e., a computer program. *See Examination Guidelines for Computer Related Inventions 1184 OG 87, 90 (3/26/1996) IV.B.1. (a)* which states:

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things" nor are they statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized.

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Furthermore, a series of steps to be performed on a general, non-specific, computer and products for performing a process on a general, non-specific computer is not statutory matter. *See Examination Guidelines for Computer Related Inventions 1184 OG 87, 90 (3/26/1996) IV.B.2. (a)(i) and (ii)* which states:

Claims that define a computer-related invention as a specific machine or specific article of manufacture must define the physical structure of the machine or manufacture in terms of its hardware or hardware and "specific software."

Furthermore, there are no independent physical acts that can be construed as significant pre- or post-computer process activity. *See Guidelines, 1184 OG at 92-93, IV.B.2. (d)(ii)-(iii)*. Finally, the claimed steps are abstract manipulations without any limitation to a practical application. *See Guidelines, 1184 OG at 92-93, IV.B.2. (e)*.

Claim Rejections - 35 USC § 112

4. Claims 1-7 and 9-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are full of grammatical errors and dangling clauses which make the scope of the claims. indeterminate.

5. Claims 1-7 and 9-21 are rejected as failing to define the invention in the manner required by 35 U.S.C. § 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent cited.

For examination, the claims were understood as a software method of copy protection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-7 and 9-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stringer ('429).

8. Claims 1-7, and 9-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ananda ('645).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Specification

10. The specification is replete with grammatical errors too numerous to mention specifically. Examples of such errors are missing prepositions, the improper use of tenses, improper matching of number (noun-verb agreement), use of multiple pronouns which make the identification of antecedent unclear, and run-on sentences. Many awkwardly constructed sentences appear in the specification, portions appear to have missing text, and some sections are incomprehensible.

11. A substitute specification in proper idiomatic English and in compliance with 37 C.F.R. § 1.52 (a and b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

Information Regarding Communication with the PTO


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. T. Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Pinchus M. Laufer
April 17, 1997

PML


THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
GROUP 2200